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09/925,020	08/09/2001	Fusasuke Gotoh	Q65831	2484

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EXAMINER

KRAMER, DEVON C

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/925,020
Filing Date: August 09, 2001
Appellant(s): GOTOH ET AL.

Jeffrey Schmidt
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/6/06 appealing from the Office action
mailed 6/10/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

JP-1122753	Tanaka	Jun 1999
6,170,625	Tanaka	Jan 2001
JP-2000-119673	Iso et al	04-2000
6,329,326	Iso et al	Dec 2001
5,655,844	Takano	Aug 1997
4,371,220	Brucher	02-1983
4,629,337	Teramachi	12-1986
4,650,195	Dreschmann et al	03-1987

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- 1) Claims 1, 9, 17 and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-1122753 to Tanaka in view of JP-2000-119673 to Iso et al and U.S. Patent No. 5655844 to Takano.
- 2) Claims 2 and 10 are rejected under 103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of US Patent 4,371,220 to Brucher.
- 3) Claims 3 and 11 under 103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of US Patent 4,629,337 to Teramachi.

4) Claims 4 and 12 under 103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of Brucher and Teramachi.

5) Claims 5 and 13 under 103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of US Patent 4,650,195 to Dreschmann et al.

6) Claims 6 and 14 under 103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of Bucher and Dreschmann.

7) Claims 7 and 15 under 103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of Teramachi and Dreschmann.

8) Claims 8 and 16 under 103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of Brucher, Teramachi, and Dreschmann.

(10) Response to Argument

Appellant argues that there is no suggestion to combine the references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all of the reference cited are related to roller bearings and the roller bearing structure. It is clear that one of ordinary skill in the art would be inclined to combine the cited references in order to create a roller bearing having better wear characteristics. Iso et al is used for the teaching of

using grease in a roller bearing. It is notorious in the art to provide grease in bearing members to reduce friction and ensure the life of the bearing. Takano is used for the teaching of a positive radial clearance between the inner and outer rings of the roller bearing and clearly states in col. 2 lines 30-36 that this increases the life of the bearing.

On page 12 of the brief appellant argues that the reference to Takano is non-analogous art. In response to applicant's argument that Tanako is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the base reference (Tanaka), and the reference to Takano teach the use of roller bearing used with rotating shafts (see Takano Col. 1 lines 5-7). Please note that Takano recites, "The present invention relates to a rolling bearing unit used for example for rotatably supporting a rotating shaft of a screw compressor". Please note that both reference utilize bearings to support a rotating shaft.

Clearly Takano teaches that by designing a bearing with a positive effective clearance, the bearing life is improved (Col. 2 lines 30-37). Further, it is clear that the contact area is gradually shifted in the reference to Takano due to the presence of the clearance. See gap 9.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Devon Kramer

DEVON C. KRAMER
PATENT EXAMINER

Devon Kramer
5/4/06

Conferees:

Jim McClellan

Jim McClellan

Thomas Hannon

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